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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,765	03/10/2004	Petteri Poyhonen	042933/271450	3955
826 7590 11/19/2009 ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			EXAMINER GONZALEZ, AMANCIO	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 11/19/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/797,765

Applicant(s)

POYHONEN, PETTERI

Examiner

AMANCIO GONZALEZ

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 08/12/2009
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

In view of the Pre-Brief Appeal Conference decision on 08/26/2009, PROSECUTION IS HEREBY REOPENED. New ground of rejection applied as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid. A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Dwayne D. Bost/
Supervisory Patent Examiner,
Art Unit 2617

Claim Objections

Claim 54 is objected to because of the following informalities: Claim 54 appears to be a dependent claim; however said dependency is directed to the claim itself.

For the purpose of examination, dependency for claim 54 will be attributed to claim 46.

Appropriate correction is required.

Disclosed Invention

The present application discloses establishing a SIP communication session with a terminal.

Claimed invention

The present application claims establishing a communication session with a terminal, the apparatus comprising:

a processor located in a network across which an originating client is configured to communicate, wherein the processor is configured to receive a connection request, and in response thereto, send a network-independent trigger to the terminal, wherein in response to the trigger, the processor is also configured to receive a registration message from the terminal via the network to thereby register the terminal with the apparatus and acquire a network-dependent identity of the terminal to thereby enable establishment of a communication session with the terminal based upon the network-dependent identity of the terminal.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-13, 15-22, 31, 34-40, 42-49, and 51-54 are rejected under 35

U.S.C. 102(e) as being anticipated by Ilnicki et al. (US 6751677 B1), hereafter "Ilnicki."

Consider **claim 1**. Ilnicki discloses:

establishing a communication session with a terminal (**see fig. 7 and column 9 lines 31-35, where Ilnicki discusses a communication being established between two client devices and a gateway**);

a processor located in a network across which an originating client is configured to communicate (**processor reads on gateway -see fig. 7 and column 9 lines 31-35, where Ilnicki discusses a communication being established between two client devices and a gateway**), wherein the processor is configured to receive a connection request (**see column 8 lines 29-33 and fig. 3**), and in response thereto, send a network-independent trigger to the terminal (**network-independent read on out-of-band -see column 8 lines 33-37, and fig. 3**), wherein in response to the trigger, the processor is also configured to receive a registration message from the terminal via the network to thereby register the terminal with the apparatus and acquire a network-dependent identity of the terminal to thereby enable establishment of a communication session with the terminal based upon the network-dependent identity of the terminal (**registration reads on authentication -see column 8 lines 37-45**).

Claims 10, 19, 28, 37, and 46 address the same subject matter as claim 1, therefore same rejection applies.

Consider **claim 2**. Illicit teaches claim 1, and further discloses receive/sending connection establishment parameters, i.e., communication request and authentication processes (see column 8 lines 33-42, where Ilnicki discusses authentication and communication establishment between the gateway and the client).

Consider **claims 6, 15, 24, 33, 42 and 51**. Ilnicki teaches claims 1, 10, 19, 28, 37, and 46 and further discloses effecting communication through a firewall (see figure 3, the title, the abstract, and column 3 lines 36-38).

Consider **claims 8, 17, 35, 44, and 53**. Ilnicki teaches claims 1, 10, 19, 28, 37, and 46 and further teaches wherein the processor is located in a network across which an originating client is capable of at least one of directly and indirectly communicating (see column 4 lines 57-67, column 5 lines 1-3, and figs. 3).

Consider **claims 9, 18, 36, 45, and 54**. Ilnicki teaches claims 8, 17, 44, and 46 above and further discloses private and a public network (see column 6 lines 1-5).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. **Claims 4, 14, 23, 32, 41, and 50** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ilnicki et al. (US 6751677 B1), hereafter "Ilnicki," in view of Stanforth (US 20020058504 A1), hereafter "Stanforth."

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Consider **claims 4, 14, 23, 32, 41, and 50**. Ilnicki teaches claims 1, 10, 19, 28, 37, and 46, but does not particularly refer to or disclose SIP protocol.

Stanforth, in related art, discloses SIP protocol (see pars. 0040 and 0044).

A person of ordinary skill in the art should have had knowledge that SIP protocol was well known at the time the invention was made, utilized in particular communication applications as, for example, Voice Over IP (VoIP), as shown by Stanforth (see paragraph 0040).

Allowable Subject Matter

5. Claims 3, 5, 7, 11-13, 16, 25, 27, 34, 38-40, 43, 47-9, and 52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Amancio González, whose telephone number is (571)

270-1106. The Examiner can normally be reached on Monday-Thursday from 8:00am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dwayne Bost, can be reached at (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

AG/ag

November 2

/Dwayne D. Bost/
Supervisory Patent Examiner,
Art Unit 2617